

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

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BOARD OF PATENT APPEALS  
AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte WOLFGANG MATTHES, LUTZ RICHTER and ANDREAS STEINERT

Appeal No. 2005-0996  
Application No. 09/848,583

HEARD: JUNE 8, 2005

Before FRANKFORT, MCQUADE and BAHR, Administrative Patent Judges.  
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-10, 12 and 13. Claim 11 stands withdrawn from consideration as not being directed to an elected invention.

BACKGROUND

The appellants' invention relates to a cutting device for trimming margins of products, in particular, stitched or otherwise joined-together sheets of paper, the cutting device having a transport device and first drive mechanism for driving the transport device, a lifting device for moving knives for performing the margin trim and a second

drive mechanism for driving the lifting device. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The examiner has not rejected any of the claims in this application on the basis of prior art.

The following rejections are before us for review.

Claims 1-10, 12 and 13 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1-10, 12 and 13 also stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as their invention.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed May 18, 2004) for the examiner's complete reasoning in support of the rejections and to the brief (filed February 26, 2004) for the appellants' arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims and to the respective positions articulated by

the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The basis of the examiner's rejection of claims 1-10, 12 and 13 under 35 U.S.C. § 112, first paragraph, as articulated by the examiner on page 3 of the answer, is that it is unclear how the lifting device 2 uses the vertical, nonharmonic oscillatory motion described on page 10, in lines 19-24, of the appellants' specification. The examiner is concerned because it is uncertain, from the appellants' underlying disclosure, if the entire lifting mechanism 2 moves up and down to move the knives 3 toward knives 13 or if the lifting mechanism pivots to drop the knives 3 down to cut the workpiece. According to the examiner, "[t]he functional language provided is not supported with any structure shown in the Figures or any structural language explaining how the lift mechanism moves knives 3 towards knife 13 to create the cutting action" (answer, page 3).

Insofar as the enablement requirement is concerned, the dispositive issue is whether the appellants' disclosure, considering the level of ordinary skill in the art as of the date of the appellants' application, would have enabled a person of such skill to make and use the appellants' invention without undue experimentation. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563-64 (CCPA 1982). In calling into question the enablement of the appellant's disclosure, the examiner has the initial burden of advancing acceptable reasoning inconsistent with enablement. Id. To be enabling under § 112, a patent must contain a description that enables one skilled in

the art to make and use the claimed invention. That some experimentation is necessary does not preclude enablement; the amount of experimentation, however, must not be unduly extensive. Atlas Powder Co. v. E.I. DuPont de Nemours & Co., 750 F.2d 1569, 224 USPQ 409, 413 (Fed. Cir. 1984).

The examiner is certainly correct that the appellants' specification and drawings provide no details as to how the transmission 22, shown merely as a box in Figures 1 and 2 of the appellants' drawings, converts the rotary motion of pulley 21, driven by drive motor 1 via a synchronous belt, into "vertical, nonharmonic oscillatory motion of the knife lifting device 2" as stated on page 10 of the specification. The lack of disclosure as to this aspect of the invention is somewhat puzzling, in light of the appellants' acclaim of the "realization of nonharmonic courses of motion" as making it "possible to move the knives quickly away from the product after the cut has been made, thus enabling rapid transport of the product outwardly" (specification, page 8). Nevertheless, the examiner's conclusion that, because of the lack of detailed disclosure of the lifting device and the transmission of rotary motion of the drive motor 1 and pulley 2 to vertical, nonharmonic oscillatory motion of the knife lifting device 2, one of ordinary skill in the art would not be able to make and/or use the invention recited in claims 1-10, 12 and 13, is lacking in two respects. First, none of the claims before us on appeal recites a mechanism for moving the knife lifting device 2, presumably corresponding to the "stroke device for moving knives" as recited in claims 1 and 12, in a vertical, nonharmonic oscillatory manner. Rather, claims 1 and 12 merely recite a stroke device

for moving knives for performing the trimming of the margins and a second drive for driving the stroke device, with the second drive for driving the stroke device being separate and independent from the drive for the transport device.<sup>1</sup> Second, The examiner has not explained, and it is not apparent to us, why one of ordinary skill in the field of the appellants' invention would have been unable, without undue experimentation, to make a cutting apparatus having a transport device for transporting product, a stroke device for moving knives for trimming margins of the product and separate and mutually independent drives for the transport device and for the stroke device. The movement of the stroke device in any direction and in any manner would meet the broad limitations of these claims.

For the foregoing reasons, we cannot sustain the examiner's rejection of claims 1-10, 12 and 13 under 35 U.S.C. § 112, first paragraph. Inasmuch as the examiner's rejection of claims 1-10, 12 and 13 under 35 U.S.C. § 112, second paragraph, as being indefinite is grounded on the perceived failings of the specification discussed above, we also cannot sustain this rejection.

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<sup>1</sup> The 35 U.S.C. § 112 rejections before us in this appeal, as well as the absence of any prior art rejections, suggest that perhaps the examiner may have interpreted the claims more narrowly than the claim language requires.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-10, 12 and 13 under 35 U.S.C. § 112, first and second paragraphs, is reversed.

REVERSED

  
CHARLES E. FRANKFORT  
Administrative Patent Judge

  
JOHN P. MCQUADE  
Administrative Patent Judge

  
JENNIFER D. BAHR  
Administrative Patent Judge

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